

**AMENDMENTS TO THE DRAWINGS**

The attached sheet(s) of drawings includes changes to Figs. 2C, 3, 6A, and 6B.

**REMARKS**

Claims 1-21 are pending. Claims 19-21 were withdrawn and claims 1-18 stand rejected. By virtue of this response, claims 1, 2, 6, 7, 10, and 18 have been amended, claims 19-21 are cancelled, and new claims 22 and 23 have been added. Accordingly, claims 1-18, 22, and 23 are currently under consideration. The amendments to the claims are fully supported by the detailed description and the figures; accordingly, no new matter has been added. Furthermore, amendment of certain claims is not to be construed as a dedication or abandonment of any unclaimed subject matter by Applicants, and moreover, Applicants have not acquiesced to any rejections and/or objections made by the Patent Office. Applicants explicitly reserve the right to pursue prosecution of any subject matter in continuation applications.

**New Claims**

Applicants have added new claims 22 and 23 and submit that the features are not disclosed or suggested by the applied art. Claim 22 recites that “the cartridge transport assembly comprises a horizontally disposed tray assembly for supporting the cartridge retrieving mechanism.” Further, claims 23 recites “the first assembly comprises a horizontally disposed tray assembly for supporting the second assembly.” The features of a horizontally disposed tray assembly are fully supported, e.g., by Figures 1, 2A and cartridge transport assembly 120 shown therein; accordingly no new matter has been added.

**Drawings**

The drawings are objected to because A) the movement of the carriages as claimed in claims 1-6 and claims 10-12 must be shown, and B) the z-axis motor (page 7, paragraph [0029]) is not shown in the drawings.

A) Applicants have amended Figs. 2C, 3, 6A, and 6B herein to include arrows illustrating movement (both linear and rotational) of the cartridge retrieval mechanism as recited in claims 1-6 and claims 10-12. The amendment is fully supported by the specification as originally

presented and no new matter has been added. The amendments to the figures are fully supported by the specification; accordingly, no new matter has been added. Applicants further note that Figures 7A and 7B originally include motion for some of the recited features as indicated by arrow "E." Accordingly, the drawings clearly show every feature of the invention as specified in the claims.

B) Applicants submit that the z-axis motor 168 is clearly shown in Fig. 4C. Accordingly, Applicants request that the objection be withdrawn.

### **Claim Objections**

Claim 6 is objected to because of the term "about." Applicants have amended claim 6 herein to delete the term "about" and replace the term with "orthogonal to." Accordingly, Applicants request the rejection be withdrawn.

Claim 10 stands objected to because Applicant claims a first, second, and third carriage, but only mentions one carriage 137 in the specification; the Examiner has assumed Applicant meant for carriage to mean the assemblies 150, 500, 600, and/or 700. The Examiner's assumption is correct and claim 10 has been amended accordingly. Accordingly, Applicants request the rejection be withdrawn.

### **Claim Rejections under 35 U.S.C. §112**

Claims 7 and 10 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the limitation "the vertical support member" lacks sufficient antecedent basis in the claims.

Claim 1 (from which claim 7 depends) and 10 have been amended to recite "a vertical stationary support member," thereby providing sufficient antecedent basis in the claims for the limitations at issue. Accordingly, Applicants believe the rejection is now overcome.

**Claim Rejections under 35 U.S.C. §102**

Claims 1 and 2 stand rejected under 35 U.S.C. 102(b) as being anticipated by Krayner (U.S. Patent No. 5,548,521).

Applicants have amended claim 1 as indicated herein to recite a storage library system comprising “a vertical stationary support member.” Applicants submit that the features of claim 1 as amended are not disclosed or reasonably suggested by Krayner. In particular, Krayner fails to disclose “a vertical stationary support member,” in combination with the other features of claim 1.

The Office Action identifies rail assembly 14 (as shown in FIG. 1) as a “stationary support member,” however, it is clear that rail assembly 14 is a horizontal member and not a vertical support member as recited. For example, rail assembly 14 is shown running along the floor or base of the data carrier library in FIG. 1.

Furthermore, there is no suggestion to modify the assembly of Krayner to include a stationary vertical support member as recited by claim 1. For example, as seen in Fig. 2, the horizontal support member 14 facilitates movement of data carrier handling device 16 with the system and between multiple data carrier stores 12, 22a-c, and so on. See, e.g., Krayner, col. 12, lines 51-60. Accordingly, one of ordinary skill in the art would not be motivated to modify Krayner to meet the features of claim 1, and further, such a modification would impermissibly change the principle of operation of Krayner (e.g., the library comprising “rotary towers 12 arranged on either side of a rail assembly 14 designed for travel of a data carrier handling device 16 thereon.” Krayner, col. 12, lines 14-18).

Accordingly, for at least these reasons, Applicants request the rejection be withdrawn and claims 1 and 2 allowed.

**Claim Rejections under 35 U.S.C. §102/103**

A. Claims 3-7, 10-14, and 18 stand rejected under 35 U.S.C. 102(b) as anticipated by Krayner (U.S. Patent No. 5,548,521) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Krayner in view of Panissidi (U.S. Patent No. 4,229,136).

Claims 2-7 depend from claim 1 and are allowable over Krayner for at least similar reasons as claim 1. Further, Panissidi fails to cure the deficiencies of Krayner. Accordingly, the rejection should be withdrawn and claims 2-7 allowed.

Claim 10 has been amended similarly to claim 1 to recite “a vertical stationary support member.” As discussed above, Krayner fails to disclose or reasonably suggest a vertical stationary support member. Accordingly, the rejection should be withdrawn and claims 10-14 and 18 allowed.

Furthermore, Applicants submit that the addition of Panissidi fails to disclose or suggest the features of independent claims 1 and 10. Panissidi discloses a 4 degree robotics system for a non-tape cartridge manipulator using arms and joints, and which is driven pneumatically. Such a disclosure does not provide a teaching, suggestion, or motivation to combine the references, let alone modify Krayner to meet the features of claims 1 and 10. Specifically, Panissidi does not, and the Examiner has not identified anything therein, that would suggest to one of ordinary skill in the art to modify the disclosure of Krayner to include a stationary vertical support member. Further, any such modification of Krayner to include a stationary support member would clearly change the principle of operation of Krayner; for example, the principle of operation including rail assembly 14 disposed to allow travel of a data carrier handling device 16 to access various data carrier stores 12, 22a-c, and so on. See, e.g., Krayner: col. 12, lines 51-60.

Accordingly, for at least these reasons, Krayner and Panissidi fail to disclose or suggest the features of claims 1 and 10, whether taken alone or in combination.

B. Claims 8 and 9 stand rejected under 35 U.S.C. 103(a) as being obvious over Kraye (U.S. Patent No. 5,548,521) in view of Panissidi (U.S. Patent No. 4,229,136) as applied to claim 7, and further in view of Hakenewerth (U.S. Patent No. 5,183,999).

Claims 8 and 9 depend ultimately from claim 1 and are allowable over Kraye for at least similar reasons as claim 1. Further, the addition of Panissidi and Hakenewerth fail to cure the deficiencies of Kraye. Accordingly, the rejection should be withdrawn and claims 8 and 9 allowed.

C. Claim 15 stands rejected under 35 U.S.C. 103(a) as being obvious over Kraye (U.S. Patent No. 5,548,521) in view of Panissidi (U.S. Patent No. 4,229,136) as applied to claim 10, and further in view of Hanaki (U.S. Patent No. 6,483,204).

Claim 15 depends from claim 10 and is allowable over Kraye for at least similar reasons as claim 10. Further, the addition of Panissidi and Hanaki fail to cure the deficiencies of Kraye. Accordingly, the rejection should be withdrawn and claim 15 allowed.

D. Claims 16 and 17 stand rejected under 35 U.S.C. 103(a) as being obvious over Kraye (U.S. Patent No. 5,548,521) in view of Panissidi (U.S. Patent No. 4,229,136) as applied to claim 10, and further in view of Hakenewerth (U.S. Patent No. 5,183,999).

Claims 16 and 17 depend ultimately from claim 1 and are allowable over Kraye for at least similar reasons as claim 1. Further, the addition of Panissidi and Hakenewerth fail to cure the deficiencies of Kraye. Accordingly, the rejection should be withdrawn and claims 16 and 17 allowed.

**CONCLUSION**

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 249212023500. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: July 14, 2006

Respectfully submitted,

By   
Christopher B. Eide

Registration No.: 48,375  
MORRISON & FOERSTER LLP  
755 Page Mill Road  
Palo Alto, California 94304-1018  
(650) 813-5720